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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,792	10/23/2003	Robert L. Newell	A-00.47	7180

7590

10/19/2004

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EXAMINER
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NGUYEN, TUAN N

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/691,792	NEWELL, ROBERT L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tuan N. Nguyen	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12,14,15 and 19-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-11,13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to an improvement in an applicator implement, classified in class 401, subclass 284.
  - II. Claims 19-26, drawn to a method for delivering a fluid material to an applicator, classified in class 401, subclass 284.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as one without the specific of the stem as claimed in lines 4-23 of claim 1.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I: Figs. 1 and 2;

Species II: Fig. 8; and

Species III: Fig. 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 1 is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Arthur Jacob on October 1, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18. The applicant further elected to prosecute Species I: Figs. 1 and 2.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 12, 14, 15 and 19-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claim 6 is hereby being examined as best understood.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to the difference between the "outer peripheral boundary" in lines 2-3 and the "outer peripheral boundary" in lines 3-4.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Glassman et al. (hereinafter Glassman).

In regard to claim 1, Glassman discloses an improvement in an applicator implement having an applicator for applying a fluid material from a source to a surface, the improvement comprising: a stem (see Fig. 4) having a first end (the bottom of member 12) and a second end (the top of member 12), and an outer peripheral surface

extending along the stem between the first end and the second end, in a direction along an axis (see Fig. 4, the axis in the middle of member 12 from the top thereof to bottom thereof); an applicator (brush 15) including a first portion secured to the stem adjacent the first end of the stem and a second portion projecting beyond the first end in a direction away from the second end (see Fig. 4), the first portion of the applicator being spaced inwardly from the outer peripheral surface toward the axis, and the second portion having an outer peripheral boundary; a transverse area extending across the stem, adjacent the first end, between the outer peripheral surface and the outer peripheral boundary (see Fig. 4); and a plurality of lumens (17) extending through the stem from the first end to the second end, the lumens extending along the direction of the axis and spaced apart from one another in an array around the axis (see Fig. 1), each lumen being spaced from the axis and from the outer peripheral surface to lie between the axis and the outer peripheral surface, each lumen having an inlet adjacent the second end of the stem for receiving fluid material to be conducted from the source through the lumen, an outlet adjacent the first end of the stem for delivering the fluid material received at the inlet, and a transverse cross-sectional area, at least at the outlet, substantially smaller than the transverse area adjacent the first end of the stem, each outlet being located between the outer peripheral boundary of the second portion of the applicator and the outer peripheral surface and juxtaposed with the outer peripheral boundary of the second portion of the applicator for delivering the fluid material in a plurality of separate streams of relatively small cross-sectional area corresponding to the plurality of lumens (see Fig. 5), with the streams directed to lay

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down the delivered fluid material along the second portion of the applicator at the outer peripheral boundary of the second portion of the applicator (see Fig. 5).

In regard to claim 2, the lumens (17) extend generally parallel to the axis.

In regard to claim 17, the applicator implement comprises a brush, the applicator (15) comprises bristles and the second portion comprises a bristle group projecting beyond the first end of the stem (see Fig. 4).

8. Claims 1-6, 9 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker.

In regard to claim 1, Baker discloses an improvement in an applicator implement having an applicator for applying a fluid material from a source to a surface, the improvement comprising: a stem (see Fig. 2) having a first end (about 10 and 16 of Fig. 2) and a second end (about 14 of Fig. 2), and an outer peripheral surface extending along the stem between the first end and the second end, in a direction along an axis (central axis of that in Fig. 3); an applicator (brush 11) including a first portion secured to the stem (at member 10) adjacent the first end of the stem and a second portion projecting beyond the first end in a direction away from the second end (see Fig. 2), the first portion of the applicator being spaced inwardly from the outer peripheral surface toward the axis, and the second portion having an outer peripheral boundary; a transverse area extending across the stem, adjacent the first end, between the outer peripheral surface and the outer peripheral boundary (see Fig. 3); and a plurality of lumens (define between member 17; see Fig. 3) extending through the stem from the first end to the second end, the lumens extending along the direction of the axis and

spaced apart from one another in an array around the axis (see Fig. 3), each lumen being spaced from the axis and from the outer peripheral surface to lie between the axis and the outer peripheral surface (see Fig. 3), each lumen having an inlet adjacent the second end of the stem for receiving fluid material to be conducted from the source through the lumen, an outlet adjacent the first end of the stem for delivering the fluid material received at the inlet, and a transverse cross-sectional area, at least at the outlet (about number 16 of Fig. 2 where the housing 14 started to curve in), substantially smaller than the transverse area adjacent the first end of the stem, each outlet being located between the outer peripheral boundary of the second portion of the applicator and the outer peripheral surface and juxtaposed with the outer peripheral boundary of the second portion of the applicator for delivering the fluid material in a plurality of separate streams of relatively small cross-sectional area corresponding to the plurality of lumens (see Fig. 2), with the streams directed to lay down the delivered fluid material along the second portion of the applicator at the outer peripheral boundary of the second portion of the applicator (see Fig. 2).

In regard to claim 2, the lumens extend generally parallel to the axis (see Figs. 2 and 3).

In regard to claims 3 and 4, the stem includes a bore extending from the first end toward the second end and spaced inwardly from the array of lumens toward the axis, and the first portion of the applicator is secured in the bore (see Fig. 4 for a better illustration). The bore extends from the first end of the stem to the second end.



In regard to claims 5 and 6, at least some of the lumens are spaced outwardly from the bore so as to be separated from the bore (see Fig. 3). The outlet of each of at least some of the lumens is located closely adjacent the outer peripheral boundary, spaced outwardly from the outer peripheral boundary.

In regard to claim 9, a source (12, 13) of fluid material (water) attached to the stem at the second end of the stem.

In regard to claim 16, the stem comprises a cylindrical shaft and the axis comprises a central axis of the shaft, the outer peripheral surface comprises a cylindrical surface, and the array of lumens comprises a cylindrical array extending around the central axis and spaced radially inwardly from the cylindrical surface and radially outwardly from the outer peripheral boundary of the second portion of the applicator (see Fig. 3).

In regard to claim 17, the applicator implement comprises a brush (11), the applicator comprises bristles and the second portion comprises a bristle group projecting beyond the first end of the stem (see Fig. 2).

In regard to claim 18, the stem comprises a cylindrical shaft and the axis comprises a central axis of the shaft, the outer peripheral surface comprises a cylindrical surface, and the array of lumens comprises a cylindrical array extending around the central axis and spaced radially inwardly from the cylindrical surface and radially outwardly from the outer peripheral boundary of the second portion of the bristle group (see Figs. 2 and 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler in view of Baker.

Seidler discloses and applicator having a resiliently flexible container that can act as a pump as claimed and a brush applicator connected thereto for applying a fluid material to a surface. Although the Seidler brush applicator does include the stem and lumens as claimed, attention is direct to the Baker reference, which teaches the brush applicator including the stem and lumens as discussed above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the brush applicator of Seidler with the brush applicator as, for example, taught by Baker, where in so doing would involve mere substitution of one functional equivalent applicator for another and the selection of any of these known equivalents to apply a fluid to a surface would perform equally well on the Seidler device.

***Allowable Subject Matter***

10. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu and Kratochvil disclose other applicator with lumens for directing fluid from a source to a surface.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 703-306-9046. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tuan Nguyen  
Primary Examiner  
Art Unit 3751  
10/15/04

TN